

11-23-04

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T-378 P.018/032 F-764

( )  
Appl. No. 09/838,821  
Amendment dated September \_\_\_\_, 2004  
Reply to Office Action of May 23, 2003

### REMARKS

Claims 1-3, 6-9, and 14 have been amended. New claim 15 has been added.  
Accordingly, Claims 1-3, 6-9, and 14-15 are pending in the application.

### Abandonment

The instant divisional application was abandoned for failure to respond to the outstanding office action dated 5/23/03. As discussed with the Examiner and presented in the Statement Requesting Reinstatement of the application, the Office Action was sent to the incorrect attorney of record in the case. A Revocation and Power of Attorney Document was properly submitted in this case with the Divisional Application filing documents, but was apparently not recorded by the USPTO.

### Objections to the Specification

The Examiner has objected to the specification as failing to properly recite the continuity data. Applicants respectfully alert the Examiner to the preliminary amendment to the specification submitted in the Divisional Application Document, at page 2, numbered paragraph 6 (copy attached). This paragraph, however, recited an incorrect number for the provisional priority application, and was corrected in the subsequent preliminary amendment received by the PTO on June 4, 2001, and acknowledged by the Examiner in this Office Action on page 2. Removal of this objection is requested.

### Information Disclosure Documents

The Examiner has stated the IDS submitted on July 23, 2001 fails to comply with 37 CFR 1.97, 1.98, and MPEP 609, because items listed on the Form 1449 were not provided to the Examiner. In contrast to the Examiner's comments, 37 CFR 1.98(d) states that copies are required UNLESS the information was submitted in an earlier application or cited by the Examiner in the earlier application and (1) the earlier application is properly identified in the IDS and is relied on for an earlier effective filing date; and (2) the IDS submitted in the earlier application complies with (a)-(c) of this

11-23-04

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T-379 P.020/032 F-764

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section. Applicant submits the IDS received by the PTO on July 23, 2001 fully complies with these requirements.

Copies of each of the sixty literature publications listed in the Form 1449 were provided to the Examiner in the parent application, and were considered by the Examiner, as evidenced by the marked copy returned to Applicant by the Examiner. If the Examiner has misplaced any of these references and would like a further copy, Applicants will resend any such publications at the Examiner's request.

### **Claim Objection**

The Examiner has objected to claims 4 and 5. Applicant respectfully asserts this objection is moot in light of the cancellation of claims 4 and 5 in the preliminary amendment submitted with the filing of the Divisional application. Removal of this objection is requested.

### **Examiner's Rejections Under 35 USC 112**

The Examiner's rejections are addressed to claims 1-14, and do not account for the preliminary amendment of the claims. To the extent the rejections apply to the pending and amended claims, they are addressed below.

The Examiner objected to the claim language in the preamble of method claim 1. This claim has been amended as suggested by the Examiner, to more properly recite "A method to inhibit c-jun activation comprising".

The Examiner suggested that the claim language relating to a substance that inhibits the activity of JAK-3 is unclear. Applicants have amended the claim language for clarity to require contacting the cells with a "JAK-3 inhibitor". Applicants submit JAK-3 inhibitors are well described and exemplified in the specification, including at pages 9-11 and in Figure 4.

11-23-04

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T-379 P.021/032 F-764

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The Examiner's statements relating to the influence of exposure to agents such as UV radiation on inhibition of c-jun is unclear. As claimed, and as disclosed and exemplified in the specification, c-jun is activated on exposure to agents such as ara-C, a topoisomerase II inhibitor, ultraviolet radiation, an alkylating agent, or ionizing radiation. Administration of a JAK-3 inhibitor effectively inhibits C-jun expression in response to such agents. See, for example, the specification at page 8-9, the working Examples, and Figures. Removal of this rejection is respectfully requested.

#### Non-Statutory Double Patenting

The Examiner has rejected claims 1, 4-5, and 9-13 under the doctrine of obviousness-double patenting, over claims 1-7 of copending Application 09/345,815. Applicants respectfully note that this is a PROVISIONAL double patenting rejection, and will respond to the rejection upon indication of patented claims from the 09/345,815 application.

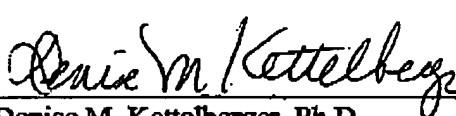
#### CONCLUSION

In view of the foregoing, the Applicants believe that all claims as currently pending are in condition for allowance and such action is respectfully requested. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903

Date: 15 September 2004

  
Denise M. Kettelberger, Ph.D.  
Reg. No. 33,924  
Tel: 612.371.5268



Enclosures

Page 7 of 7